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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,028	05/02/2006	Wolfgang Gottmann	S3-03P07671	4067
24131 7590 09/05/2007 LERNER GREENBERG STEMER LLP P O BOX 2480 HOLLYWOOD, FL 33022-2480			EXAMINER NGUYEN, TRAN N	
			ART UNIT 2834	PAPER NUMBER
			MAIL DATE 09/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/564,028

Applicant(s)

GOTTMANN ET AL.

Examiner

Tran N. Nguyen

Art Unit

2834

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 11-23.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see attachment for response to arguments.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

Tran N. Nguyen  
Primary Examiner  
Art Unit: 2834

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 8/16/07 have been fully considered but they are not persuasive.

The applicant contends that *Kaeufl* provides "an anti-interference unit with interference suppression components 23 (for example capacitors)." Page 2, para. [0015] (Fig. 2). The purpose of the interference suppression corresponds to that of the instant application, namely, the suppression of noise signals from motor commutation and brush arcing. The modification of *Kaeufl* with *Parker*, it would appear that *Kaeufl* was not even aware of the problem pointed out by applicants. The "space-savings" issue apparently does not come into play in *Kaeufl*. While the TSM test may not be applicable here, the modification is also not obvious under the Graham test. The modification, it is respectfully pointed out, is arrived only in a hindsight construction. It is indeed applicants' disclosure that first points to the problem associated with the prior art and then provides for a solution to the problem. The modification - replacing the capacitor-type attenuation element of *Kaeufl* with the common mode ferrite bead of *Parker* - is not fairly taught in the prior art.

***In response to the applicant's argument***, the applicant correctly points out that **Kaeufl's** invention about providing an anti-interference unit with interference suppression components for suppressing EMI. So does *Parker's* invention. **Parker** discloses an interference suppression component, particularly common mode ferrite bead, for suppressing EMI/RFI. *Parker* also discloses that the common-mode ferrite bead is configured so that it is a high impedance common mode bead for surface mount applications, such as printed circuit board; therefore, the

ferrite body may be configured as conveniently small dimensions such as with a length of approximately 0.394" (10 mm), a width of approximately 0.260" and a height of approximately 0.15711" (4 mm) (Parker's col. 2, lines 45-60). **Parker** not only discloses a common mode ferrite bead for suppressing EMI/RFI but also discloses that such common mode ferrite bead being conveniently small dimensions to define an acceptable footprint on a circuit board. **Thus, Parker does provide both motivations for suppressing EMI/RFI and space compacting.**

The obviousness rejection, under 35 U.S.C. 103(a), does not require the primary ref; in this case Kaeufl, to raise problem or concern. It requires the secondary ref, in this case Parker, to provide motivations and/or solutions to modify and/or to improve the invention. In this case, **Parker ref clearly provides two motivations: (1) a high impedance common mode bead, as an interference suppression component, for enhancing the suppressing EMI; and (2) such high impedance common mode bead is conveniently small dimensions to define an acceptable footprint on a circuit board for space compacting. Thus, the rejection relied on Parker prior art reference is proper.**

Regarding the allegation that the rejection is an improper hindsight construction, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

**Thus, the applicant's argument regarding Parker ref is found to be not persuasive.**

*In response to the applicant's argument that Haag's printed circuit board (PCB) (84) which is inserted in the housing in close vicinity of the motor, wherein the PCB (84) having filters (78, 80, 82) connected in the supply circuit for the motor. The PCB, according to the applicant's interpretation, does not carry a motor control circuit.*

In response to this argument, the applicant's attention is drawn to **Haag's** Figures 1-2 and 5 and col. 4 line 46 to col. 5 line 27, Haag discloses a printed circuit board (PCB) (84) that is inserted in the motor housing (28) in close vicinity of the motor (34), which is placed in the overall casing (22). **Haag particularly discloses that the PCB (84) having filters (78, 80, 82) connected in the power supply circuit for the motor. This is interpreted as part of the motor control circuit because the PCB (84) wire traces connected to the filters (78, 80, 82) to define a circuit that control and filter the motor's high frequency noise operating current to prevent it from shunting back to the motor.** Such circuit board arrangement would enhance electrical reliability while requiring a compact installation space. **Thus, the rejection relied on Haag prior art reference is proper.**

Furthermore, for the argumentative point of view, even though **Haag** does disclose a PCB having a motor control circuit, but **Haag does disclose a PCB located within the motor housing and at vicinity of the motor. This is the essential teaching of PCB placement for enhance electrical reliability while requiring a compact installation space.**

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the

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art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this instant case, the Examiner's position is NOT suggesting to bodily incorporated whatever kind of Haag's PCB into the structure of the Kaufl primary reference or vice versa. The Examiner's position is that since **Kaeufl** does disclose a PCB with motor control circuit, as in para. [0015], and **Haag** teaches a PCB being located within the motor housing and close to the motor for enhance electrical reliability and compact installation space. Hence, it would have been obvious to an artisan to rearrange the Kaeufl's motor control circuit PCB by placing it within the motor housing and close to the motor, as taught by Haag, because it would enhance electrical reliability while requiring a compact installation space thereof.

**Thus, the applicant's argument regarding Haag ref is found to be not persuasive.**

**The Final Rejection is hereby maintained.**

### ***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran N. Nguyen whose telephone number is 571-272-2030. The examiner can normally be reached on 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 571-272-2044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. (Note: Use this **Central Fax number 571-273-8300 for all official response.**)

Do **not** use the Examiner's RightFax number without informing the Examiner first because, according to the USPTO policy, any document being sent via RightFax is treated as unofficial response and will not be officially dated until it is routed to the Central Fax.

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Tran N. Nguyen  
Primary Examiner  
Art Unit 2834